

## **REMARKS**

This amendment is submitted along with an RCE in response to the final Office Action mailed July 30, 2007 (“Office Action”). After entry of this Amendment, claims 35-46, 49, and 51-52 will be pending. Claims 35 and 52 are independent. In the Office Action, the Examiner:

- rejected claims 35-47 and 49-50 under 35 U.S.C. § 102(e) (“Section 102(e)”) as anticipated by U.S. Pat. No. 6,264,650 to Hovda *et al.* (“Hovda”); and
- rejected claims 35-50 under 35 U.S.C. § 103(a) (“Section 103(a)”) as unpatentable over Hovda in view of U.S. Pat. No. 5,846,220 to Elsberry (“Elsberry”).

Claim 35 has been amended to partially incorporate the recitation of dependent claim 49 and thereby to recite that the at least one marking effector creates a position marker “at a third tissue location.” Claim 35 has further been amended to incorporate the recitation of dependent claim 50 and thereby recite that “the at least one injury effector and the at least one marking effector are capable of being sequentially actuated by a control structure.” Claims 38 and 49 have been amended for formal reasons in light of the amendment to claim 35, from which they depend. Claim 50 has been cancelled in light of the amendment to claim 35, from which it depended.

Claim 51 has been added. Claim 51 depends from claim 35 and incorporates the recitation of independent claim 47 that “the second tissue location is below an outer surface of the tissue.” Claim 47 has been cancelled in light of new claim 51.

Claim 52 has been added. Claim 52 incorporates the recitations of independent claim 35 and dependent claim 48 and partially incorporates the recitation of dependent claim 49. Claim 48, which depended from claim 35, has been cancelled in light of new claim 52.

No new matter has been added.

### ***Rejection Under Section 102(e)***

Claims 35-46 and 49, as well as cancelled claim 50, are rejected under Section 102(e) as anticipated by Hovda. Applicant respectfully requests that this rejection be withdrawn.

Independent claim 35 recites that “the at least one injury effector and the at least one marking effector are capable of being sequentially actuated by a control structure.” Hovda does not disclose, teach, or suggest an injury effector and a marking effector that “are capable of being sequentially actuated by the control structure.” The Examiner alleges that element

104 of Hovda serves as both an injury effector and as a marking effector. (Office Action at 2.) Therefore, actuation of the injury effector *necessarily* actuates the marking effector, to the extent one exists, and vice-versa. Sequential actuation is not disclosed, taught, or suggested, and is, in fact, *impossible* with the device described in Hovda.

Therefore, the rejection of claim 35 as anticipated by Hovda should be withdrawn. Because claims 36-46 and 49 depend from independent claim 35, the rejection of those claims should be withdrawn for at least the same reason that the rejection of claim 35 should be withdrawn.

Furthermore, claim 49 recites that the “third tissue location [marking location] is different from the first tissue location [injury location] and the second tissue location [delivery location].” Hovda does not disclose, teach, or suggest a marking location different from an injury location. Even if the Examiner correctly identified element 104 of Hovda as a marking effector, because the Examiner also identified element 104 as the injury effector, the device of Hovda is not capable of creating a position marker at a tissue location different from the tissue location of an injury. Therefore, the rejection of claim 49 by Hovda should be withdrawn for at least this additional reason.

#### ***Rejection Under Section 103(a)***

Claims 35-46 and 49, as well as cancelled claims 47-48 and 50, are rejected under Section 103(a) as obvious over Hovda in view of Elsberry. Applicant respectfully requests that this rejection be withdrawn.

With respect to independent claim 35, Elsberry fails to remedy the defects of Hovda, because Elsberry does not disclose, teach, or suggest “at least one marking effector . . . for creating a position marker at a third tissue location to indicate treated tissue,” and therefore, like Hovda, fails to disclose, teach, or suggest that “the at least one injury effector and the at least one marking effector are capable of being sequentially actuated . . . .” The Examiner submits that radiopaque marker 46 is a marking effector. (Office Action at 3.) Applicant respectfully disagrees. Radiopaque marker 46 of Elsberry is located on distal end 14 of catheter 10 and is a “means for locating distal end 14 during the access and location process.” (Col. 7:40-45 and Fig. 7.) Radiopaque marker 46 does not and *cannot* “create[] a position marker at a *third tissue location*,” nor does it “*indicate treated tissue*,” as recited in claim 35. (Emphasis added.) Thus, even if the Examiner is correct that the recitation of “creating a position marker at a third tissue location” is functional (Office Action at 3), the device of

Elsberry is *not capable* of performing this function. Additionally, radiopaque marker 46 is used to locate the *device* of Elsberry, not treated tissue. Because Elsberry fails to disclose, teach, or suggest a marking effector, it necessarily fails to disclose, teach, or suggest an injury effector and a marking effector that “are capable of being sequentially actuated . . . .”

Therefore, Hovda and Elsberry, alone or in combination, fail to disclose each and every element of independent claim 35. Thus, the rejection of independent claim 35 as obvious over Hovda in view of Elsberry should be withdrawn. Because dependent claims 36-46 and 49 depend from independent claim 35, the rejection of those claims should be withdrawn for at least the same reason that the rejection of claim 35 should be withdrawn.

Claim 49 recites that the “third tissue location [marking location] is different from the first tissue location [injury location] and the second tissue location [substance delivery location].” As discussed, Hovda does not disclose, teach, or suggest a marking location different from an injury location. Elsberry fails to disclose, teach, or suggest marking tissue at any location, and therefore cannot remedy the deficiency of Hovda. The rejection of claim 49 under Section 103(a) should be withdrawn for at least this additional reason.

#### ***New claims 51-52***

Claim 51 depends from independent claim 35 and is therefore patentable over Hovda in view of Elsberry for at least the same reason that claim 35 is patentable over Hovda in view of Elsberry.

Independent claim 52 recites that “the at least one marking effector is separate from the at least one injury effector.” The Examiner admits that Hovda “fails to teach making the marking effector separate from the injury effector.” (Office Action at 3.) Elsberry fails to remedy this deficiency. Claim 52 recites “at least one marking effector . . . for creating a position marker at a third tissue location to indicate treated tissue.” As discussed in above in connection with independent claim 35, Elsberry does not disclose, teach, or suggest such a “marking effector.” Therefore, it necessarily does not disclose, teach, or suggest making a marking effector separate from an injury effector. Thus, claim 52 is patentable over Hovda in view of Elsberry for at least this reason.

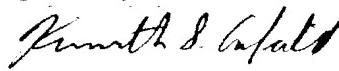
**CONCLUSION**

It is believed that claims 35-46, 49, and 51-52 are in condition for allowance. Should the Examiner not agree with any of Applicant's positions or arguments herein, a telephonic or personal interview is respectfully requested to discuss and resolve any remaining issues.

An RCE is filed herewith. Other than the fee for the RCE, no fee is believed due for this response. Should any additional fee(s) be due at this time, please charge such fee(s) to Jones Day Deposit Acct. No. 50-3013.

Respectfully submitted,

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